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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

073612.0108

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on July 14, 2006

Signature

Typed or printed name Alfonso Juarez

Application Number

09/866,373

Filed

May 25, 2001

First Named Inventor

Richard L. Schwartz et al.

Art Unit

2151

Examiner

Phillips, Hassan A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 48,363
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Paula D. Heyman

Typed or printed name

512.322.2581

Telephone number

July 14, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".

☐ *Total of _____ forms are submitted.

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ATTORNEY DOCKET
073612.0108

PATENT APPLICATION
09/866,373

1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Richard L. Schwartz et al.

Serial No.:

09/866,373

Date Filed:

May 25, 2001

Group Art Unit:

2151

Examiner:

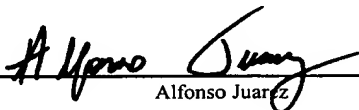
Phillips, Hassan A.

Title:

**METHOD AND SYSTEM FOR
FACILITATING INTERACTIVE
COMMUNICATION**

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P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EV352444325US addressed to: Mail Stop – Amendment, Commissioner of Patents, Office, P.O. Box 1450, Alexandria, VA 22313-1450, on July 14, 2006.


Alfonso Juarez

Dear Sir:

PRE-APPEAL REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicants contend that the rejections of Claims 1, 3-6, 9-47, 49-52 and 55-101 on prior art grounds contain clear legal and factual deficiencies, as described below. As of the time of the Final Office Action dated February 14, 2006, Claims 1, 33, 47, 79 and 93 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,564,261 issued to Gudjon M. Gudjonsson et al. ("*Gudjonsson*") in view of U.S. Patent No. 5,758,280 issued to Misa Kimura ("*Kimura*"). Claims 1, 3-6, 9-47, 49-52 and 55-101 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,430,602 issued to Timothy Kay et al. ("*Kay*") in view of *Gudjonsson* and further in view of *Kimura*. Applicants request a finding that these rejections are improper and allowance of these claims.

With respect to Claim 1, the Examiner contends that the combination of *Gudjonsson* and *Kimura*, whether or not in further combination with *Kay*, teach, disclose, suggest or otherwise render obvious each element of Claim 1. (Final Office Action, Pages 2-7). Applicants contend that there is no motivation, teaching or suggestion to combine *Gudjonsson* and *Kimura*, or *Gudjonsson*, *Kay* and *Kimura* for the reasons described in Applicants' Response dated April 13, 2006 at Pages 27-29. In short, Applicants contend that it is improper to combine the cited references, as *Gudjonsson* and *Kimura* teach away from such a combination.¹

To illustrate, *Gudjonsson* discloses that in connection with the method and apparatus disclosed therein, a routing service is employed that allows users to send requests (i.e. invitations) for communications sessions to other users, as well as configure how these invitations are handled depending on the user's current presence information. (Col. 3, Lines 9-13). *Gudjonsson* further discloses, "[t]he routing service allows users to send invitations to other users to establish an arbitrary communication session ... over arbitrary networks. *The requests are not sent directly between users.*" (Col. 3, Lines 14-17) (emphasis added). Therefore, "no network addresses need to be exchanged between the users, thus *retaining the*

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

anonymity of the users.” (Col. 3, Lines 29-31) (emphasis added). Hence, utilizing the routing service disclosed by *Gudjonsson*, “a user may establish a communications session with another user without knowledge of the client device (e.g., PC, mobile phone, etc.) being used by the other user.” (Col. 3, Lines 51-54).

On the other hand, *Kimura* discloses an apparatus which has a “first display for detecting the calling apparatus on the receipt of a call, and displaying the [identity of the] calling apparatus.” (Col. 1, Lines 59-61). Hence, while *Gudjonsson* teaches that communication requests are not sent directly between users and that the identity of a communication device is to remain anonymous, *Kimura* contemplates direct communication between user devices in which the identity of user devices is disclosed. Therefore, each of *Gudjonsson* and *Kimura* teaches away from the combination of *Gudjonsson* and *Kimura*, whether or not in further combination with *Kay*. A prior art reference must be considered in its entirety, including portions that would lead or teach away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. § 2141.02(VI). Hence, there is no motivation to combine *Gudjonsson* and *Kimura*, whether or not in further combination with *Kay*.

Furthermore, the proposed combinations are improper because they render the prior art unsatisfactory for their intended purposes and because they would change the principle of operation of a reference. As discussed above, *Gudjonsson* discloses a method and system for establishing communications whereby communication requests are not sent directly between users, and the identity of the communications devices remain anonymous. If *Gudjonsson* were to be combined with *Kimura*, communication requests would be sent directly between users and the identity of communications devices would not remain anonymous. Accordingly, the proposed modification is improper. See M.P.E.P. § 2143.01 (V) (“If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”); M.P.E.P. § 2143.01(VI) (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified,

then the teachings of the references are not sufficient to render the claims *prima facie* obvious”).

Applicants also contend that, even assuming, *arguendo*, the references cited by Examiner may be properly combined, such references cannot render obvious the rejected Claims, because the references fail to disclose, teach, suggest or make obvious each element of the rejected Claims for the reasons described in Applicants’ Response dated April 13, 2006 at Pages 29-30. In short, Applicants contend that none of *Gudjonsson*, *Kay* or *Kimura*, whether alone or in combination, disclose, teach, suggest or make obvious a method comprising “receiving from the second user via the second communication device a reply for accepting the request [for implementing an interactive communication session with the second user], the reply for accepting the request selected by the second user during the mediated communication session from at least one response displayed on the second communication device,” as recited in Claim 1. Specifically, none of the references disclose a reply selected to accept a request for implementing an interactive communication session during a mediated communication session. Applicants further note that each of the Final Office Action and the Advisory Action mailed May 22, 2006 fail to establish a *prima facie* case of obviousness with respect to Claim 1, in that the Examiner has not alleged that the combined references teach or suggest all the claim limitations, as contemplated by M.P.E.P. § 706.02(j).²

For at least the reasons cited above, *Gudjonsson*, *Kay* or *Kimura*, whether alone or in combination, fails to disclose, teach, suggest or otherwise render obvious each and every limitation of independent Claim 1. Applicants respectfully contend that the arguments provided in the Final Office Action and maintained by the Advisory Action are clearly flawed and the teachings of the cited referenced do not anticipate Claim 1. For these reasons, and the above-referenced reasons described in Applicants’ Response dated April 13, 2006,

² M.P.E.P. § 706.02(j) provides, in relevant part: “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Applicants contend that in the present case, the Examiner has not established of record a *prima facie* showing of obviousness of Claim 1 and other Claims amended by Applicants in the Response dated April 13, 2006, which the Examiner has indicated have been entered for the purposes of appeal. (Advisory Action). Accordingly, a *prima facie* case has not been shown and the rejection under 35 U.S.C. § 103(a) is improper.

Applicants contend that the rejection of Claim 1 is improper, as is the rejection of Claims 3-6, 9-47, 49-52 and 55-101 for the same or analogous reasons.

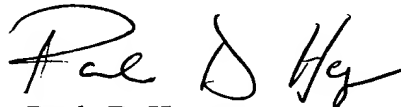
CONCLUSION

As the rejections of Claims 1, 3-6, 9-47, 49-52 and 55-101 contain clear deficiencies, Applicants respectfully request a finding of allowance of Claims 1, 3-6, 9-47, 49-52 and 55-101. Applicants submit these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicants enclose a check in the amount of \$250.00 for the Notice of Appeal, a Petition for Two Month Extension of Time, and a check in the amount of \$225.00 for the extension fee.

Applicants believe there are no further fees due at this time; however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this request that may be cleared up in a telephone conversation, please contact Applicants' attorney, Paula D. Heyman, at 512.322.2581.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants



Paula D. Heyman
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Date: July 14, 2006

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